

1 UNITED STATES DISTRICT COURT

2 DISTRICT OF MASSACHUSETTS

3 No. 1:19-cv-12533-WGY

4 BIO-RAD LABORATORIES, INC., et al
5 Plaintiffs

6 vs.

7 10X GENOMICS, INC.
8 Defendant

9 No. 1:19-cv-11587-WGY

10 BIO-RAD LABORATORIES, INC., et al
11 Plaintiffs

12 vs.

13 STILLA TECHNOLOGIES, INC., et al
14 Defendants

15 *****

16 For Zoom Hearing Before:
17 Judge William G. Young

18 Markman Hearing

19 United States District Court
20 District of Massachusetts (Boston)
21 One Courthouse Way
22 Boston, Massachusetts 02210
23 Thursday, September 10, 2020

24 *****

25 REPORTER: RICHARD H. ROMANOW, RPR
Official Court Reporter
United States District Court
One Courthouse Way, Room 5510, Boston, MA 02210
bulldog@richromanow.com

A P P E A R A N C E S

EDWARD REINES, ESQ.
DEREK C. WALTER, ESQ.
AUDRA SAWYER, ESQ.
JUSTIN CONSTANT, ESQ.
GARLAND STEPHENS, ESQ.
Weil, Gotshal & Manges, LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
(650) 802-3022
Email: Edward.reines@weil.com
For Plaintiff, Bio-Rad Laboratories

MICHAEL J. TUTEUR, ESQ.
GEOFFREY RAUX, ESQ.
RUBEN J. RODRIGUES, ESQ.
Foley & Lardner, LLP
111 Huntington Avenue, Suite 2500
Boston, MA 02199
(617) 342-4000
Mtuteur@foley.com
For Plaintiff President and Fellows of Harvard College

SARAH CHAPIN COLUMBIA, ESQ.
McDermott, Will & Emery, LLP
28 State Street
Boston, MA 02109
(617) 535-4074
Email: scolumbia@mwe.com

and

MATTHEW D. POWERS, ESQ.
AZRA M. HADZIMEHMEDOVIC, ESQ.
PAUL T. EHRLICH, ESQ.
ROBERT L. GERRITY, ESQ.
JENNIFER K. ROBINSON, ESQ.
Tensegrity Law Group, LLP
555 Twin Dolphin Drive, Suite 360
Redwood Shores, CA 94065
(650) 802-6010
Email: matthew.powers@tensegritylawgroup.com
For Defendant 10X Genomics, Inc.

(Continued.)

(Continued.)

ELIZABETH G.H. RANKS, ESQ.
WHITNEY A. REICHEL, ESQ.
JUANITA R. BROOKS, ESQ.
QIUYI WU, ESQ.
NICOLE WILLIAMS, ESQ.
MICHAEL LAMARRE, ESQ.
Fish & Richardson, P.C. (Boston.)
One Marina Park Drive
Boston, MA 02210-1878
(617) 542-5070
Email: Wreichel@fr.com
For Defendant Stilla Technologies, Inc.

1 P R O C E E D I N G S

2 (Begins, 2:00 p.m.)

3 THE CLERK: Now hearing Civil Matter 19-11587,
4 Bio-Rad versus Stilla, and 19-12533, Bio-Rad versus 10X.

5 THE COURT: Good afternoon, counsel. This is a
6 hearing held under our zoom facilities. Hosting the
7 hearing is Courtroom Deputy Clerk, Jennifer Gaudet. We
8 have on the line our Official Court Reporter, Rich
9 Romanow, and law clerks. It is a hearing that naturally
10 is open to the press and public, and so I have no way of
11 knowing whether any members of the press or public are
12 on the line, but if they are, I must instruct you to
13 keep your microphones muted. And should there be any --
14 well, keep in mind that the rules of court remain in
15 full force and effect and that means there is no
16 retransmission, streaming, taping, or other broadcast of
17 this proceeding.

18 Now with that said, would counsel identify
19 themselves and who they represent starting with Bio-Rad.

20 MR. REINES: Thank you, your Honor. This is
21 Edward Reines from Weil Gotshal on behalf of Bio-Rad,
22 and I'll let the other attorneys that are going to be
23 presenting today introduce themselves, so you know them
24 and see them, and the same with the Court Reporter.

25 THE COURT: Thank you.

1 MR. CONSTANT: Your Honor, Justin Constant on
2 behalf of Bio-Rad.

3 MR. WALTER: Your Honor, this is Derek Walter on
4 behalf of Bio-Rad.

5 MS. SAWYER: And this is Audra Sawyer on behalf of
6 Bio-Rad.

7 MR. STEPHENS: Good afternoon, your Honor, this is
8 Garland Stephens on behalf of Bio-Rad.

9 THE COURT: Thank you.

10 All right. And 10X?

11 MS. COLUMBIA: Good afternoon, your Honor, this is
12 Sarah Columbia from the Boston office of McDermott.
13 Presenting today will be attorneys from the Tensegrity
14 Law Group, and I think Mr. Reines's idea was a good one,
15 so I will let them introduce themselves so you can see
16 them. And we also have in attendance today, um,
17 Dr. Richard Fair, who is the expert witness who
18 submitted a declaration in connection with the markman
19 briefing.

20 THE COURT: Thank you.

21 MR. POWERS: Good afternoon, your Honor, this is
22 Matt Powers for 10X.

23 MS. HADZIMEHMEDOVIC: Good afternoon, your Honor,
24 this is Azra Hadzimehmedovic on behalf of 10X.

25 MS. ROBINSON: This is Jennifer Robinson for 10X.

1 MR. GERRITY: Good afternoon, your Honor, this is
2 Robert Gerrity for 10X.

3 MR. EHRLICH: Good afternoon, your Honor, Paul
4 Ehrlich for 10X.

5 THE COURT: I didn't catch your last name? I'm
6 sorry.

7 MR. EHRLICH: Paul Ehrlich, your Honor.

8 THE COURT: Ehrlich, yes. Thank you.

9 MS. COLUMBIA: And I should add, your Honor, we
10 have in attendance, um, the General Counsel for 10X,
11 which is Eric Whittacker, and in-house counsel, Randy
12 Wu.

13 THE COURT: Thank you.

14 And for Stilla?

15 MS. RANKS: Good afternoon, your Honor, this is
16 Liz Ranks from Fish & Richardson, and I'm going to let
17 my colleagues who are presenting today introduce
18 themselves as well.

19 THE COURT: Surely.

20 MS. BROOKS: Good afternoon, your Honor, Juanita
21 Brooks from Fish & Richardson on behalf of Stilla.

22 MS. WILLIAMS: Nicole Williams at Fish &
23 Richardson on behalf of Stilla.

24 MS. WU: Good afternoon, your Honor, this is Qiuyi
25 Wu from Fish & Richardson for Stilla.

1 MR. LAMARRE: Good afternoon, your Honor, this is
2 Michael Lamarre from Fish & Richardson on behalf of
3 Stilla.

4 MS. REICHEL: This is Whitney Reichel from Fish &
5 Richardson on behalf of Stilla.

6 THE COURT: Thank you.

7 All right. One housekeeping matter, and I think
8 Ms. Gaudet has told you. We would like -- you've
9 delivered copies of these slides and the like. I do
10 want those in electronic form. You may already have
11 filed them. But I'll need those for the Court Reporter
12 and the law clerks, because it's easier for them to work
13 with them in that form.

14 Now, I do have --

15 MR. TUTEUR: Your Honor, may I interrupt for a
16 moment? I'm sorry. This is Michael Tuteur, we're here
17 for Harvard, who is also a party in this matter, and I
18 just wanted to make sure that the record didn't get too
19 far along before we identified ourselves for the record.
20 So it's Michael Tuteur from Foley & Lardner for the
21 President and Fellows of Harvard College, and my two
22 colleagues will introduce themselves as well.

23 THE COURT: Thank you, Mr. Tuteur, and I did not
24 mean to skip over you. I'm well aware that Harvard is a
25 party here.

1 Are you going to argue a position today?

2 MR. TUTEUR: No, your Honor, but we'll be watching
3 with great interest.

4 THE COURT: All right, I thank you. And I'm happy
5 to meet your colleagues.

6 MR. RAUX: Good afternoon, your Honor, Jeffrey
7 Raux from Foley & Lardner.

8 THE COURT: Thank you.

9 MR. RODRIGUES: Good afternoon, your Honor, Ruben
10 Rodrigues also from Foley & Lardner.

11 THE COURT: Thank you.

12 MR. TUTEUR: All set, your Honor.

13 THE COURT: And I thank you very much. Well I
14 thank you all, the briefing has been helpful and
15 thorough, and I really do appreciate your focusing on
16 what seemed to be significant issues. And here's how I
17 propose to proceed now that I have read the briefs and
18 reflected on these matters, though you have much to
19 teach me.

20 In large measure, and this is too broad a brush,
21 but in large measure Bio-Rad says, "Well these things
22 have a plain and ordinary meaning," and the various
23 defendants say, "Well, no, they don't," um, and I think
24 we can best grapple with these if we at least start out
25 by discussing those where it occurs to me that the plain

1 and ordinary meaning perhaps does not work.

2 And so here's where I want to start, and it's in a
3 dispute that 10X focuses on, though I'll hear from
4 Stilla if they have an oar in this, um, and 10X, as to
5 the '444 patent, Claim 1, and the '277 patent, Claim 1,
6 argues for, um, that the claim term "ordering of method
7 steps" is something other than the plain and ordinary
8 meaning.

9 I have to say that it -- at least from the
10 briefing, it seems to me that 10X has the better of the
11 argument, but I propose something slightly different,
12 and I propose to, um, explain to the jury that -- and
13 now follow this language, "The claimed method steps must
14 be initiated in the listed order." Not "performed," as
15 the defendants say, but "must be initiated in the listed
16 order."

17 Now we'll start with, um, Bio-Rad. Isn't that an
18 accurate and explanatory, um, exposition of that claim
19 term?

20 MR. REINES: Thank you, your Honor, and this is Ed
21 Reines from Weil on behalf of Bio-Rad, um, addressing
22 this term and the Court's good question.

23 I think in general that is acceptable because it
24 comports with the concept of potential simultaneity, um,
25 and let me just get another layer in, and the Court can

1 just stop me or pull me along, whatever you prefer. But
2 is that -- you have this continuous droplet generator
3 that's just draining droplet after droplet in, and the
4 plurality to be any subset. So these systems use
5 millions of them, right, there's millions of droplets,
6 there's certainly thousands in any kind of method. And
7 so you might have a plurality for purposes of the claim
8 read -- that's just a plurality, let's just say of 10
9 for simplicity. So within the million matter going, for
10 claim purposes you're looking at 10 of them as a
11 plurality.

12 It is certainly possible that you're creating 1
13 droplet and you'd create, let's say, 6 of the drops, and
14 they're starting to go into the pool, in the
15 microcapsule -- because there's no need for them to go
16 anywhere else, they come out of an orifice or whatever
17 and they go into, let's say into the pool, that 6 of
18 them could be there. And so you've already begun the
19 pooling step, but that the droplet step is not complete
20 for that subset plurality of 10, um, until the 10th one
21 is completed.

22 So what the Court's saying is for that plurality,
23 um, it is conceivable that you could -- that it could be
24 required that you provide the droplet generator, okay
25 that happens, but --

1 THE COURT: Well let me stop you only in this
2 sense. What I'm groping for here -- the way we will do
3 this as a practical matter -- I mean my rulings, when I
4 make them on claim construction, may have pretrial
5 implications in terms of motions for summary judgment
6 and the like, but when we get to trial what's going to
7 happen is where I have, um, defined the term other than
8 plain and ordinary meaning, I'm going to give the jury a
9 glossary of each of those terms, and in my initial
10 charge to the jury I'm going to recite them, and the
11 Court Reporter will make a transcript of that and we
12 will give that to the jury so that they will be able to
13 look at it.

14 If you're okay with my formulation, that's fine
15 for the moment. Certainly some of its implications, as
16 you explicate them, I understand and I'm familiar with.
17 I'm not saying I buy them all.

18 So what does 10X say? I go for your proposal but
19 I want to substitute "initiated" for "performed." How
20 do you go -- what do you say to that?

21 And let me make a side comment. We're all in our
22 several offices and the like. I wouldn't do this if I
23 was on the bench, but I drink tea, and I'm going to
24 drink my tea as we talk together. Don't take that as
25 any sign of disrespect and feel free to drink any

1 nonalcoholic beverage.

2 What does 10X have to say?

3 MR. POWERS: Thank you, your Honor. I think, your
4 Honor --

5 (Interruption by Court Reporter.)

6 MR. POWERS: This is Matt Powers for 10X.

7 THE COURT: Yes. And the Court Reporter -- this
8 is difficult for the Court Reporter and if you'd do this
9 as we go along.

10 Go ahead, Mr. Powers.

11 MR. POWERS: Thank you, your Honor.

12 I think your proposed revision captures in part
13 what we think is the right answer and I want to make
14 very clear what our position is and is not. Our
15 position is not that if you are making a million
16 droplets, that all million droplets must be made before
17 a single droplet is pooled, which is the next step, and
18 our position is not that the entire million droplets
19 must be pooled before you conduct a reaction.

20 What our position -- that is not our position,
21 although Bio-Rad is -- I think it's implied that it is,
22 because the claim doesn't say that the entirety of the
23 production of droplets must be performed and completed.

24 THE COURT: But "initiated" would leave that open?

25 MR. POWERS: "Initiated" leaves that open, but it

1 leaves an ambiguity in one important respect, your
2 Honor, and that important respect is -- I think it may
3 help illustrate the argument if you look at our Slide
4 A-8, which has the claim --

5 THE COURT: I've got everything here, you just
6 have to give me a moment.

7 MR. POWERS: Certainly, your Honor. It's Slide
8 A-8, which is -- which is the order-of-steps decl.

9 (Pause.)

10 THE COURT: I have it.

11 MR. POWERS: Bio-Rad's patent counsel chose to use
12 a very specific form of claim which involves antecedent
13 basis claiming about deplurality of droplets -- that
14 they use the term "microcapsules," but we've been using
15 the word "droplets," and I think for our purposes that's
16 equivalent for this discussion. And A-8 walks through
17 the steps and highlights the antecedent language used,
18 which is a very specific form of claim drafting that has
19 particular and distinct effects.

20 The first step is to provide a plurality of
21 droplets, that's those aqueous microcapsules. Now we're
22 not saying that that plurality has to be all new, but it
23 does have to be a plurality, two of them, whatever that
24 number is. But the important part of the claim
25 structure, if you go to the following three steps, it's

1 always "pooling the microcapsules," which is an
2 antecedent basis for the ones that were provided in Step
3 1, "such that a portion of the plurality" -- that's the
4 same plurality, it's not just any number, it's the same
5 plurality, and that particular form of claim drafting
6 has a consequence, because that means you have to be
7 doing, operating on that plurality in Step 2. So it's
8 not just operating on some capsule, it's the same
9 plurality that you made in Step 1.

10 So while your Honor is absolutely right that they
11 are initiated in order and the steps need not be
12 completed for purposes of the process you're running --
13 in other words not all million droplets need to have
14 been formed, for purposes of the claim the plurality of
15 droplets has to be first formed, whatever that plurality
16 is, and then that plurality has to be pooled into the
17 separate compartments. And in the third step, that same
18 plurality within the compartments -- so it has to have
19 existed beforehand, they're conducting a reaction on
20 that very same plurality. And in the fourth, you're
21 detecting the product of the enzymatic reactions.

22 You have a -- as I say, a very specific form of
23 claim drafting that was chosen, which has the
24 consequence that that same plurality has to be tracked
25 all the way through the claim.

1 So while your Honor is exactly right that they are
2 initiated in that sequence and that in a process/flow
3 sense they need not be completely performed, that
4 plurality has to be performed in Step 1 before it can be
5 acted on in Step 2.

6 THE COURT: Well I'll react to what you say by
7 saying I follow that and that's how I read this English
8 language, but I say that's plain and ordinary. So I
9 don't have to say any more than what I propose. And I
10 think I'm going to stick with what I do propose.

11 MR. POWERS: May I comment on that, your Honor?

12 THE COURT: Yes.

13 MR. POWERS: The -- as long as it's clear that you
14 agree with what I'm saying and I think --

15 THE COURT: Well you know I agree with what you're
16 saying until someone persuades me that that's wrong.
17 That's how I read the language. But I can only deal
18 with what I'm going to say to the jury here, that's what
19 the exercise is, and I don't propose to say all that to
20 the jury.

21 MR. POWERS: You did --

22 THE COURT: I say it and I'm not going to say it.

23 MR. REINES: Your Honor, this is Ed Reines, can I
24 respond? Because I think we're joining it up and
25 narrowing the issue in a helpful way.

1 THE COURT: Yes. Yes.

2 MR. REINES: So I think we're all in agreement
3 that when you apply this claim to a method, you're not
4 applying it to all million -- that's a point of
5 agreement, not disagreement between Bio-Rad and 10X, um,
6 but that when you apply for that plurality, the point is
7 that your Honor's correct in the language -- and I think
8 Mr. Powers is actually disagreeing with your Honor, that
9 the change that you're making is the change he doesn't
10 want made. His position is that the method only covers
11 the plurality and that all of Step 1 has to be complete
12 before Step 2 goes forward, and so on and so forth, and
13 I don't believe that that's correct.

14 THE COURT: But he didn't say that. He didn't say
15 that. He's talking, as I follow him, um, if we look at
16 his slide here, A-8, the use of the -- in the second
17 phrase there, "pooling the microcapsules," that's -- as
18 I read the English language, that's the, um, what's
19 produced in Step 1. It's not something else. And the
20 use of that same article, as we go through, does, as I
21 read it, mean we trace through what we're doing here in
22 these various steps.

23 MR. REINES: Your Honor, there's no question about
24 that, but the point where we're all joined up, and we
25 can join it up right now as to what the disputed issue

1 is, um, is that, for example, if your plurality is 10
2 drops, it's going to be a plurality, it's going to be
3 more than 2, everyone agrees it's not a million, it
4 doesn't need to be, but if it's 10, that if the droplet
5 generator is dropping the droplet into the common
6 compartment to create a pool of them, the first 5 will
7 be part of that pool. So the second step will be
8 "initiated," to use the Court's intelligent term, but
9 yet the first step won't be complete because the last 5
10 haven't even been necessarily generated.

11 And then it goes to whether providing a droplet
12 generator is actually making the droplets, which it's
13 likely not, but let's just say that it was for purposes
14 of this discussion. So if you have 5 droplets that are
15 generated, 1, 2, 3, 4, 5, and they were placed into the
16 common compartment, they're already being pooled. The
17 first five haven't been generated yet, so that
18 generation step hasn't happened.

19 And then the point that Mr. Powers really put his
20 weight on, "such that a portion of the plurality of the
21 microcapsules contact each other," that's a portion of
22 the plurality. That reinforces our position that it's
23 not all of them that need to be in there. So it could
24 that you're creating the pool, and in the process of
25 creating the pool, you're providing a droplet generator.

1 And so on and so forth. So it can begin to act on the
2 next one.

3 And what I would say, just as a cap on this, your
4 Honor, is that the **Kaneka** case is right on point. If
5 you read one case, it's that case. And in **Kaneka** it's
6 exactly like this where it's one step, the step is
7 oxidation, and then, um, there has to be another active
8 step on it. And what the Court said there is exactly
9 what your Honor said -- honestly, exactly, which is it
10 has to be initiated in the sequence, but it doesn't have
11 to be completed, in other words oxidation doesn't have
12 to be absolutely completed before the next process
13 starts, it just said "oxidation," then the next point.

14 THE COURT: Well this is a work in progress in the
15 sense that what I'm doing this afternoon, and for
16 however long it takes us, is, um, trying to construe
17 these claims. Now once we get done that, um, at least
18 that will be my construction and we'll see what
19 implications that has. But for now we're going to
20 adopt, as to the first of the two disputes, um, my
21 formulation, "The claim method steps must be initiated
22 in the listed order."

23 Now I want to skip then to, um, this -- the third
24 issue, um, where, um, we have -- we're talking about, in
25 Patent Number '277, Claim 3, and, um, the claim term is

1 "primers for a polymerase chain reaction." And the
2 choice that I'm given here is Bio-Rad says "plain and
3 ordinary meaning" and, um, 10X gives me a definition.

4 Now 10X's definition is a definition that finds
5 support in the literature, um, but at least as I read
6 your briefs and reflect on them, that may not be the
7 only, um, way to do it. And the fact that Bio-Rad's
8 teaching in its specifications teaches that way doesn't
9 narrow its claim to that specific way. But I feel that
10 I have to do something more on this disputed issue than
11 simply say, in this extraordinarily complex area, "Well
12 this is the plain and ordinary meaning," because we're
13 going to be in front of the jury battling over what the
14 plain and ordinary meaning is. And that is, um, while I
15 hesitate to say it's a matter of law, I've always had
16 trouble with the jurisprudence in this area, but, um, to
17 say it straight out, what I'd like from Bio-Rad is how
18 broadly do you claim here is "plain and ordinary
19 meaning"? These are technical terms. I'd like a
20 preferred definition as broad as you think the patent
21 office gave you in this claim and then that's something
22 we can argue about.

23 Am I making any sense to you in what I'm asking
24 about, Mr. Reines?

25 MR. REINES: Yes, your Honor, and I do have this

1 term. You're making a lot of sense. And let me just
2 say three things about that.

3 One is that the 10X-proposed construction does
4 not, among other things, achieve the jury-friendly, um,
5 nature. I mean "oligonucleotide" is even more of a
6 tongue-twister than the phrase itself.

7 Second of all, and this is a point, you know, I --
8 I think you've been a leader in jurisprudence in this
9 area, as you know.

10 THE COURT: Well, no, I don't know that and that
11 will get you nowhere.

12 (Laughs.)

13 THE COURT: But look --

14 MR. REINES: Well --

15 THE COURT: It's not so much I want you to attack
16 theirs, I want to know what the problem with theirs is.
17 Arguably it may narrow your claim. I know I can't do
18 that. But I'm not clear or sufficiently clear as to
19 what this claim is or how far it goes or --

20 MR. REINES: Precisely. So what I'm saying
21 wasn't shining your shoes, what I was saying is that
22 your Honor's pointed out that sometimes you're
23 construing these things in the abstract in a claims
24 dispute that is never going to happen, and you have been
25 a leader in that, and the point I want to make on this

1 issue is that the particular PCR processes are debatable
2 -- or what's debated as PCR processes that come up at
3 trial is not going to be -- we don't have to take on the
4 universe of this ubiquitous term, we'll have a specific
5 process and then the parties can debate whether
6 "polymerase chain reaction" -- the jury's not going to
7 be on its own, each side gets an expert, and so trying
8 to like come up with, you know, an omnipurpose
9 construction.

10 But what I would say, just to underline your
11 Honor's concerns about this, is on Page 15 of the
12 responsive brief -- this is Document 149 of 10X, they
13 say, "If the applicants wanted to describe reactions
14 like, um, RT-PCR or Random-PCR that were well-known,
15 applicants could have included those techniques in the
16 specifications."

17 So they're acknowledging that there are other PCR
18 techniques that they're trying to exclude, including
19 Random-PCR, um, which you know indicates that Random-PCR
20 -- you're not necessarily -- you're using random
21 primers, so you're not bracketing a known sequence, so
22 it wouldn't fit within -- at least arguably within their
23 construction. So they're acknowledging that they're
24 trying to keep PCR processes out.

25 I don't know that I can come up with, um -- I know

1 I'm not technically skilled enough to come up with every
2 PCR reaction to my --

3 THE COURT: Let me say it back to you. Let me say
4 it back to you.

5 What you propose -- because I'm not hesitant to
6 discharge my function, as I understand markman, I'll
7 construe the patent, but you're saying to me, "Well
8 their construction is too narrow, um, in essence don't
9 venture a construction now, when you see the dispute
10 about this polymerase chain reaction, you'll be in a
11 position to rule what's within the claim and what is
12 not."

13 Have I captured what you're saying?

14 MR. REINES: Largely, although you may determine
15 that it's a Step 2 infringement question at the end of
16 the day, but, yes. That other than that, I agree with
17 you totally.

18 THE COURT: All right.

19 10X, what do you say about that, that I ought just
20 let that lie for now?

21 MS. HADZIMEHMEDOVIC: Your Honor, this is Azra
22 Hadzimehmedovic on behalf of 10X.

23 THE COURT: Yes.

24 MS. HADZIMEHMEDOVIC: Your Honor, we believe that
25 your Honor's initial inclination to actually construe

1 the term is appropriate. Whenever PCR would be --
2 before these parties PCR was construed, and this term is
3 even more complicated, it is "primers for PCR." It is
4 these types of technical terms that truly are amenable
5 to construction because the jury needs to be helped in
6 understanding why that is.

7 THE COURT: No, but your problem is, and it's one
8 that occurs in patent law, that what they've taught in
9 their specification -- which you seem, as I can make
10 sense of it, to have grabbed onto in your proposed
11 construction, doesn't cover the field, and their claim,
12 by its terms, is broader than that, and it would be
13 legal error to limit them to what's taught in the
14 specification. That's all I'm saying.

15 MS. HADZIMEHMEDOVIC: Two responses to that, your
16 Honor. One has to do with the structure of the claim as
17 they issued, as the named inventors intended it to be,
18 and if you could, your Honor, um -- this set of slides
19 is called "B" set of slides in the binder you have. If
20 you could please turn to Slide B-44 and I will cover
21 B-44 and B-45.

22 (Turns.)

23 THE COURT: I have it.

24 MS. HADZIMEHMEDOVIC: In these, when Harvard and
25 MIT and the named inventors meant to cover this field,

1 cover broader than just the PCR, they said that. In
2 Claim 1, they covered enzymatic reactions. In Claim 2
3 they covered amplification reactions. These additional
4 types of reactions that Bio-Rad is trying to put into a
5 dependent claim, Claim 3, are amplification reactions,
6 they're not the PCR reaction that Bio-Rad, Harvard, and
7 MIT claimed in Claim 3.

8 Claim 3 is narrow, it is "primers," plural, "for a
9 delivery chain reaction PCR." And Part 2 of that -- and
10 the meaning is you cannot now be reading this narrow
11 Claim 3 to be broader and somehow co-extensive with the
12 broader claims. They got the broader claims, they
13 should keep those, but they should not be trying to
14 expand and broaden a claim that is narrow, "primers for
15 a preliminary chain reaction PCR."

16 The second point that is extremely important in
17 this context is one is bound by the record. The record
18 here is the intrinsic record and our definition is
19 exactly from the intrinsic record. And we have slides
20 on that and we can move on.

21 THE COURT: Well, no, it's from the
22 specifications?

23 MS. HADZIMEHMEDOVIC: It is from the
24 specifications, from the second -- from the section of
25 the specification called "definitions."

1 In that section, on Claim 20, it says "polymerase
2 chain reaction," parentheses, "(PCR)," as it does here,
3 and then it says "Saiki 1988." "Saiki 1988" is an
4 article famous in the field -- I think we all agree on
5 that, it was Kary Mullis who invented PCR, who invented
6 this PCR they're claiming in Claim 3.

7 "Saiki" is an article that is in that definitional
8 part of the specification and we took our definition
9 verbatim from "Saiki." Saiki's part of the intrinsic
10 record both because it's cited there in the definition
11 and also because this patent, the '277 patent, says,
12 "I'm incorporating these articles into my
13 specification."

14 So the record is clear and they have, in other
15 sections of the specifications, lists of amplification
16 reactions. Those amplifications reactions and these
17 that are not even mentioned anywhere -- Random-PCR,
18 whatever that may be, or RT-PCR, though reactions may be
19 in these broader claims, but they're not, not in the
20 claim --

21 THE COURT: Well help me out here. Are you
22 arguing that given the patents that we have here, that
23 we're talking about, when they talk about "Polymerase
24 Chain Reaction," the "PCR," there's only one way to
25 accomplish that reaction? That's not so, is it?

1 MS. HADZIMEHMEDOVIC: The way this patent '277 is
2 written, it is defining the "PCR" as what everybody in
3 the world knew and knows now is "PCR." The Mullis PCR
4 -- he got a Nobel prize award for it, and everybody
5 knows that it is a three-step process, everybody knows
6 that the parts of our construction are actually faithful
7 to that PCR.

8 The other types of PCR -- um, whatever Random-PCR
9 may be, is an amplification reaction and they do have
10 claims on amplification reactions. This claim is for
11 PCR as defined in this patent to be Saiki PCR, Mullis
12 PCR.

13 THE COURT: Just so I am sure I understand your
14 argument and you make it very well. You're saying that
15 to one skilled in the art, when they use the term -- and
16 they get to draft the patent, when they use the term
17 "Polymerase Chain Reaction," the use of that term meant
18 this Saiki approach, and that one skilled in the art
19 would think of this -- what I have inartfully called
20 "another method," as an amplification reaction. Is that
21 correct?

22 MS. HADZIMEHMEDOVIC: That's exactly right, your
23 Honor.

24 THE COURT: All right.

25 MS. HADZIMEHMEDOVIC: And we have one of ordinary

1 skill in the art, Dr. Fair, who has confirmed that.

2 And --

3 THE COURT: Well let's see what Bio-Rad says to
4 that.

5 MR. REINES: Yes, your Honor.

6 First of all, I want to -- I'd say two things.
7 It's acknowledged that there's PCR that they're
8 excluding, Random-PCR is just one example. So PCR is
9 PCR, I just -- I don't think there's any basis to say
10 that it wouldn't encompass these other types of PCR
11 they're trying to exclude. But there has been no
12 identification that I see of a definition that would
13 disclaim -- because here the argument is "Yes, there's
14 other types of PCR," but that's not what this is, this
15 is a special safety type. There is no explicit or
16 expressed disclaimer rising, you know, to a clear
17 disvowel, nor have they argued until, I guess, now it's
18 been suggested. I just don't think this specification
19 meets the standard to, um, to constitute, um, that kind
20 of definition that's excluding, you know, things that
21 everyone agrees are PCR.

22 THE COURT: All right. I'll take the matter under
23 advisement and I thank you.

24 Let's look at the phrase "plurality of species,"
25 that's in Patent '085, Claims 1, 3, 11, and 18.

1 Now the actual claim term is, um, it has two words
2 in it. "Plurality" or "plurality of" I think can be --
3 the plain and ordinary meaning will take care of that.
4 In the terms of this patent, the '085 patent, I propose
5 that "A species" -- um, I don't -- I'm a little closer
6 to the defendant's approach here, um, in fact I'm with
7 the defendant's approach. "A species is any substance
8 that can be differentiated from the droplet fluid."

9 What's the matter with that? And we'll ask
10 Bio-Rad to tell me what's wrong with it.

11 MR. CONSTANT: Your Honor, Justin Constant, for
12 Bio-Rad.

13 THE COURT: Yes.

14 MR. CONSTANT: Well, your Honor, the problem is
15 that if a species -- if a plurality of species can
16 simply be just any two substances differentiated from
17 the droplet fluid, it effectively takes all meaning from
18 the addition to the claim. And I'd like to point or
19 look to the file history and give you a little history
20 of how this specific element was added to the claim.
21 And if you would turn to Bio-Rad's Slide 48. Um --

22 THE COURT: Wait a minute. (Turns.)

23 (Phone rings.)

24 THE COURT: Just a moment.

25 (Pause.)

1 THE COURT: Yes, 48. I have it.

2 MR. CONSTANT: So, your Honor, in response to a
3 rejection from the examiner over a combination of a few
4 references, the applicant added in specific limitations
5 -- and as you can see in Slide 48, um, this particular
6 addition was for this claim term, "plurality of." And
7 the reason they added that, um -- and one of the
8 distinguishments was that, um, Trnovsky had taught that
9 it was desirable to make sure that all of the droplets
10 only contained 0 or 1 chromosomes. So in other words,
11 the addition of a plurality would get around that
12 because it would require, um, multiple species instead
13 of just this, the single chromosome.

14 Now that argument makes little sense in light of
15 this construction where a species can simply be any
16 substance, because a chromosome itself consists of many
17 many many thousands -- or rather tens or hundreds of
18 millions of base pairs. So in that sense this
19 distinguishment, this amendment to the claims, wouldn't
20 give, um, any sort of, um, separation from the claim
21 references. So in other words, the addition of
22 "plurality of species" has to mean something more than
23 just any two individual substances.

24 Now, Bio-Rad doesn't disagree that the term
25 "species" on its own --

1 THE COURT: I'm not sure I understand the
2 language. The slide is helpful. But if we adopted
3 their and, for the moment, my proposed definition, if a
4 "species" -- if a "species" is a substance that's
5 differentiated from the droplet fluid, the language here
6 is modified, um, by -- we're talking about the current
7 meaning, wherein "the plurality of species are nucleic
8 acids." So, um, I don't see -- I don't see where you're
9 going with that? It doesn't drain it of meaning, it
10 says, "Well anything that's different than the droplet
11 fluid is a species," but, um, we're talking about the
12 plurality being nucleic acids and the rest of the
13 language there.

14 Do I grasp the meaning?

15 MR. CONSTANT: So, your Honor, I think you're
16 correct in one way, but as far as these dependent claims
17 are going to actually support Bio-Rad's position,
18 because when they're discussing the groupings, the
19 plurality of species as a group, they're referring to it
20 with a singular characteristic.

21 So in Claim 3, for example, they refer to them as
22 the nucleic acid. So in other words, you know, it's the
23 individual species needs to be nucleic acid. And the
24 same applies for nucleitides, that each one of these
25 different species would have to be polynucleitized.

1 THE COURT: Well in what you've shown me, they
2 don't all have to be, a plurality of them have to be.
3 So that means, um, whatever's the opposite of
4 "plurality," a "minority," can be something else. So
5 I'm -- I'm not sure how -- it just seems logical to say
6 a "species," as it's used here, is something different
7 than the droplet.

8 MR. CONSTANT: And, yes, your Honor, I don't think
9 we necessarily disagree with that. I think the addition
10 of "plurality of species," as used as a -- as the term
11 as it's used in the claims, um, connotes some additional
12 meaning, and that additional meaning --

13 THE COURT: It means -- it means the plain and
14 ordinary meaning. It means -- I don't mean to be too
15 simplistic because these may be terms of art, but it
16 means most of them have these other characteristics,
17 nucleic acids, etc.

18 MR. CONSTANT: Um --

19 THE COURT: I give you that. I mean the plain and
20 ordinary meaning of "plurality" is the majority, um,
21 most of them.

22 MR. CONSTANT: Well, your Honor, in -- and I do
23 agree with you that in this case I think the plurality
24 isn't necessarily talking about like a larger subset,
25 it's that there's just more than one species. But I

1 believe when used in connection -- and as a whole term
2 "the plurality of the species," it -- and in view of how
3 it was argued in the file history, um, and specifically
4 looking at the Slide 49 --

5 (Pause.)

6 THE COURT: All right.

7 MR. CONSTANT: And so these were statements made
8 by the applicant to the patent office and this was
9 submitted along with those amended claims. And as you
10 can see, Trnovsky was being distinguished because it
11 only taught that the droplets had to have 0 or 1
12 chromosomes, instead of, rather, a plurality of
13 chromosomes.

14 (Pause.)

15 THE COURT: Well I haven't got the whole reference
16 here. I don't -- that doesn't leap out at me, I have to
17 say. Let's look at the first sentence.

18 (Reads.)

19 THE COURT: Here's what I get from this paragraph
20 that you have, um, highlighted here. That what's
21 different from Trnovsky here is that the amended claims,
22 um, teach that the droplets have a plurality of species
23 of "nucleic acid" or, as set out in 25, or "primers," as
24 set out in 52. So I was too simplistic to start talking
25 about a majority or most of them, rather it is that

1 there are, um, a sufficient quantity of, um, a
2 particular type of species in Claim 25, "nucleic acids,"
3 and in Claim 52, "primers."

4 Does that get the idea?

5 MR. CONSTANT: I believe so, your Honor.

6 THE COURT: So if that gets the idea, I still
7 don't see what's the matter with -- what you've done is
8 taught me, um, a nuance of the word "plurality," which I
9 was saying "Oh, ordinary meaning," but I guess I didn't
10 understand it, but "species" can properly be defined as
11 something different than the droplet.

12 MR. CONSTANT: Well, your Honor, yeah, in -- and I
13 believe that -- again an individual species -- and as
14 it's used in the specification it can be anything that's
15 differentiated from the droplet, but when you refer to a
16 "plurality of species," there needs to be some
17 connection between these different species.

18 THE COURT: Well I agree that there does. So what
19 language do you propose?

20 MR. CONSTANT: Well, your Honor, that's, um -- so
21 our construction is just that, it's that there is some
22 connection between these various species. So "multiple
23 unique members of a common genus that are characterized
24 by some unifying property."

25 THE COURT: Well that sounds pretty complex, can't

1 we be simpler than that?

2 MR. CONSTANT: Well, your Honor, I think we may --
3 in this particular instance I think, you know, we may be
4 okay with -- or Bio-Rad would be fine for a plain or
5 ordinary meaning, or that if this does, um, come up,
6 like we discussed, with a previous term in the context
7 of a summary judgment, that may make sense. But --

8 THE COURT: Fine, it may -- again I don't mean to
9 be simplistic, though I'm a simplistic thinker. I was
10 in error and you've made it clear and I appreciate it.
11 "Plurality" in this sense does not mean "majority" in
12 any way, but what it does mean is a "bunch of them." It
13 doesn't just mean a random one around there, it means a
14 "bunch of them." A "bunch of them," given the claim,
15 are nucleic acids, or in Claim 52, a "bunch of them" are
16 primers. And that's what you're looking for. A "bunch
17 of them" may be too, um, downscale for our elite
18 profession, but, um, that's what I'm thinking about, and
19 we'll grapple with it. And I think I have the idea.
20 All right. Thank you.

21 Let's go on then. Well really I think that pretty
22 much does it for 10X. Let's turn to Stilla here.

23 Now, um --

24 MR. EHRLICH: Your Honor, before we proceed to
25 Stilla -- and this is Paul Ehrlich.

1 THE COURT: Yes, Mr. Ehrlich.

2 MR. EHRLICH: There was one more joined dispute in
3 the briefing between 10X and Bio-Rad, um, the terms --
4 "including label or tag" and, um, we just wanted to know
5 whether you wanted to hear oral argument on that term?

6 THE COURT: I do not. But I thank you very much.

7 All right, now let's turn to Stilla. And in
8 Stilla, um, here we have, um -- again my instinct is to,
9 um -- except for the ones that we're going to talk about
10 now where Bio-Rad says plain and ordinary meaning will
11 do it, I think that's correct, except as we talk about
12 the following.

13 I'm now talking about, um, the '310 patent, Claims
14 1, 15, and 27. I -- um, don't go entirely for Stilla's
15 meaning, but I propose -- I propose this meaning. A, um
16 -- where the phrase "a plurality of different primer
17 types" appears there, it seems to me that means "more
18 than one set of different primers of primer pairs each
19 set," and going on from there.

20 Do you follow the language as I've spelled it out?
21 What's the matter with that? And we'll turn to, um --
22 well that -- neither one has proposed that, so we'll
23 turn to Bio-Rad to start with that. I propose that "a
24 plurality of different primer types" means "more than
25 one set of different primers or primer pairs, each set,"

1 and so on.

2 MS. SAWYER: Your Honor, this is Audra Sawyer for
3 Bio-Rad.

4 THE COURT: Yes, Ms. Sawyer.

5 MS. SAWYER: So I think the key issue with this
6 construction is going to be that primer pairs aren't
7 necessary to conduct PCR, so our main issue with
8 Stilla's construction, and I think it also comes up here
9 as well, is that we don't believe that primers should be
10 limited to pairs.

11 Unless I misheard you?

12 THE COURT: I think maybe you did, and I think
13 you'll be more comfortable.

14 I propose to define "a plurality of different
15 primer types" as "more than one set of different primers
16 or primary pairs, each set," et cetera.

17 You're okay with that?

18 MS. SAWYER: Yes, I apologize. I --

19 THE COURT: Oh, no, your saying you're okay with
20 it is fine by me.

21 What does Stilla say? Doesn't that work?

22 MS. BROOKS: Yes, your Honor. Juanita Brooks on
23 behalf of Stilla. And we would agree, it does work.

24 THE COURT: Fine. Well good.

25 Then let's go on to, um, this, um, this one. I'm

1 in the '993 -- the '933 patent, excuse me, Claim 1.

2 "Forming a plurality of droplets of the aqueous fluid in
3 the immiscible carrier fluid." And, um, here Bio-Rad
4 says plain and ordinary meaning. Again I don't, um,
5 necessarily agree with Stilla, but I propose the
6 following. So let's be very careful with what I'm
7 saying.

8 I propose this language: "Forming a plurality of
9 droplets of the aqueous fluid by introducing a stream of
10 the aqueous fluid into the flow of an immiscible carrier
11 fluid." I'll say it again. "Forming a plurality of
12 droplets of the aqueous fluid by introducing a stream of
13 the aqueous fluid into a flow of the immiscible carrier
14 fluid." That's not a plain and ordinary meaning and
15 it's not what Stilla has proposed, so I'll hear either
16 one of you.

17 MR. WALTER: Your Honor, this is Derek Walter for
18 Bio-Rad.

19 THE COURT: Yes, Mr. Walter. Okay with that?

20 MR. WALTER: Well, no, I think we would propose a
21 slight modification. How about "Forming a plurality of
22 volume of aqueous fluid" --

23 THE COURT: "Forming a plurality of" --

24 MR. WALTER: -- "of volumes of aqueous fluid by
25 introducing a stream of the aqueous fluid into the

1 immiscible carrier fluid"? I think the trouble we have
2 with your proposal is this language of "flow." There's
3 no requirement that the carrier --

4 THE COURT: Oh, I see, you talk about volumes, but
5 let me try -- well let's see.

6 MR. WALTER: Sure.

7 THE COURT: I think what you're saying is "Forming
8 a plurality of droplets of the aqueous fluid by
9 introducing a stream of the aqueous fluid" -- and go
10 from there?

11 MR. WALTER: -- "into the immiscible carrier
12 fluid."

13 THE COURT: Okay, and I had "into a flow of an
14 immiscible carrier fluid." All right.

15 And tell me why yours is better?

16 MR. WALTER: Ours is better because it's much more
17 consistent with the claim language, the specification,
18 and just the intrinsic record overall.

19 This notion of having two flows interact with one
20 another, um, that, um, is a claim term that's -- that's
21 a conduct that's associated with a term called "plug."

22 Now, um, if you can look at our slide
23 presentation, Slide 93.

24 (Pause.)

25 THE COURT: I have it.

1 MR. WALTER: Now, the term "plug" in the patents
2 en suit is a defined term, okay, and that defined term,
3 um, refers to a type of droplet that's made by a
4 technique where you have two flows, where you have a
5 flow of the carrier fluid and you have a flow of the
6 aqueous fluid, and you can see that right there where
7 it talks about "a stream of at least one plug fluid
8 introducing to the flow of the carrier fluid." That's a
9 defined term in the patent, the term "plug."

10 This patent doesn't use the term "plug," it uses
11 the term "droplet." So your proposed definition would
12 limit the patent to the term "plug" when it doesn't use
13 that term.

14 And that's an important point, because if you look
15 at the next slide, Slide 94.

16 THE COURT: Wait a minute. Is "plug" defined in
17 this patent, the one we're talking about?

18 MR. WALTER: Yes, "plug" is a defined term in this
19 patent.

20 THE COURT: Oh, yes, I see it. Yes.

21 MR. WALTER: And your construction would have the
22 effect of limiting the patent to "plugs" when the claims
23 don't use that term.

24 THE COURT: All right.

25 MR. WALTER: And that's an important point. You

1 know the patentee could have limited it to "plugs," but
2 they didn't use the term because they didn't want to
3 limit it to "plugs." They used "droplets."

4 THE COURT: I understand. I understand the
5 concept.

6 What does Skilla say?

7 MR. WALTER: And if you look at the next slide,
8 Slide 94, we know that the term "droplets" is broader
9 than "plugs," we know that the term "droplets"
10 encompasses ways of making, um, volumes of fluid where
11 you don't have intersecting flows, and we know that from
12 their own experts. This is Page 30, Paragraphs 33 and
13 34 of their expert.

14 Here he's talking about different ways you can
15 make droplets that were known. In Paragraph 33 he talks
16 about one way where you make a microjet coming out of a
17 capillary tube. And in Slide 34 he says that another
18 way you can do it is where you have the intersecting
19 flows, okay, and -- so the point, the term "droplet" is
20 broader than what your construction originally was,
21 that's just known to someone skilled in the art, and
22 your construction will have the effect of limiting it to
23 the, um, to the, um, the defined term in the patent
24 that's not used in the claims.

25 THE COURT: I understand the argument.

1 MR. WALTER: And I can -- I have other reasons as
2 well, I mean if you'd like me to keep going, I can.

3 THE COURT: I'm not saying you've swept the field,
4 but I certainly understand your argument.

5 What does Stilla say?

6 MS. WILLIAMS: Your Honor, Nicole Williams on
7 behalf of Stilla.

8 What's important to note here is that the
9 University of Chicago, which is the patent owner for the
10 '933, has limited or says that droplets and plugs are
11 the same thing, and, um, this is not only the consistent
12 use of the term "plug" in the specification and not the
13 use of the term "droplet," but also is what the
14 University of Chicago has said directly to the patent
15 office about this specification, about this common
16 specification.

17 So if you have our slide in front of you, you can
18 look at just one example of this. On Slide 52.
19 Actually let's step back, let's start with Slide 51.

20 The provisional applications themselves, um, that
21 the '933 was based upon used "droplet" and "plug"
22 interchangeably and in fact say the term "plug" refers
23 to the droplets. They're telling the patent office,
24 "Look, 'plug' may not be a term that they're used to,
25 you understand 'droplets, they're the same thing."

1 And again, um, in the '544 provisional, um, "the
2 streams enter a microchannel with flowing oil at which
3 point droplet," and then in parentheses, "plug," "form
4 every agent come in contact." So that's directly out of
5 the provisional application.

6 And then beyond that, University of Chicago has
7 taken this same specification and told the patent
8 office, on six separate occasions, that, um -- and on
9 Slide 52 you can see this language, "The inventions of
10 the Ismagilov patents are based on the use of microfluid
11 droplets which are referred to in these Ismagilov
12 patents as 'plugs.'"

13 So this idea that now the University of Chicago is
14 saying "Oh, no, 'droplets' and 'plugs' are two different
15 things and let's imbue more breathe to the term
16 "droplets" than is to "plugs," goes directly against
17 what they told the patent office and what the basis for
18 the term "droplets" and "plugs" is.

19 And finally, I know we would agree with your
20 Honor's construction of the term.

21 THE COURT: All right. Good.

22 All right, I propose to take that under
23 advisement.

24 Now, um, in all other respects, um, with these
25 disputes, I propose to, um, apply the plain and ordinary

1 meaning of the disputed terms, which I believe I can
2 grasp and, um, I believe I can either have explained to
3 the jury or will explain to the jury. Not everyone
4 agrees and I will hear you now, if you wish. I do
5 propose to write up at least these matters that I've
6 taken under advisement and we'll go from there.

7 I have not forgotten your discovery disputes. I'm
8 working on it. You'll all get my instructions.

9 Anything else to be done this afternoon? This has
10 been extraordinarily helpful, I must tell you. You
11 people are right on the mark. It's a great pleasure to
12 working with you.

13 Anything else to be said this afternoon?

14 MS. BROOKS: Yes, your Honor, with the Court's
15 permission. Juanita Brooks on behalf of Stilla.

16 THE COURT: Yes.

17 MS. BROOKS: Going back to the '310 patents, your
18 Honor.

19 THE COURT: Yes.

20 MS. BROOKS: Bio-Rad has asked for the plain and
21 ordinary meaning for the term, Claim 1, of "providing a
22 plurality of partitions," which were later amended to
23 mean "droplets, each comprising a nucleic acid molecule"
24 --

25 THE COURT: I have read it.

1 MS. BROOKS: And a similar term appears in Claim
2 15, "amplifying the single target sequence term, a
3 nucleic asset molecule, in the droplet."

4 THE COURT: Right.

5 MS. BROOKS: And if your Honor goes to our slide
6 decl, which is still a slide decl at page, um, Slide 20.
7 What we here, your Honor, is -- we're not saying that
8 there might not be a plain and ordinary meaning to this
9 term, what we are saying is that Bio-Rad, um, in order
10 to get around rejection over the prior art, disclaimed
11 the plain and ordinary meaning, and was very specific
12 about it.

13 So if we look at Slide 20 -- and this is Bio-Rad
14 responding to the patent office rejection, and talking
15 about the prior art, and talking about in the prior art
16 "when amplifying several nucleic acid templates
17 simultaneously with multiple primers present,
18 competition between the various amplification reactions
19 result in uneven or no amplification of some target
20 sequences."

21 So they've identified a problem in the prior art,
22 which is if you're going to have various target
23 sequences, um, and have those amplified, you're going to
24 get competition between them.

25 So what do they say that their invention does that

1 distinguishes them from the prior art? We go to the
2 next slide, Slide 21, and this is Bio-Rad talking to the
3 examiner and saying that the amended claim -- so what
4 they did was they amended their claim and they amended
5 their claim to add this word "single," which has great
6 significance.

7 So they say to the examiner, "The amended claims
8 recite a solution to this problem, a method where
9 plurality of partitions," which is the same as
10 "droplets," "each comprise a single target sequence and
11 a plurality of different primer types each specific to
12 amplify a different target sequence, but only a single
13 target sequence is amplified and detected in each
14 partition." And they go on to say, "As stated in the
15 as-filed specification, even though the number of PCR
16 primer pairs per droplet is greater than 1" -- so
17 they're saying "we had multiple primer pairs." But now
18 in our amended claim, there is only one template
19 molecule per droplet. And that, your Honor, was their
20 disclaimer. And that is the language we're asking your
21 Honor to consider -- that is our construction, those
22 words right there.

23 THE COURT: Is that an appropriate role for a
24 markman hearing? Isn't that -- isn't that -- obviously
25 I mean your recitation of the law, if these facts fit

1 it, um, they're not going to be allowed now in
2 litigation to take back something they've disclaimed to
3 the patent office. But I thought I was just limited to
4 construing the language which the patent office issued.

5 Is this an appropriate time to make that legal
6 ruling?

7 MS. BROOKS: Well we believe it is, your Honor, in
8 that that would be the way to hold Bio-Rad to their
9 disclaimer and not allow them to recapture subject
10 matter that they disclaimed in order to get over the
11 prior art.

12 Now if your Honor believes that this is not the
13 appropriate forum, then I guess it would be in a forum
14 of either a jury instruction, where the jury is
15 instructed that the claim is limited to having one
16 template molecule per droplet, and that would be in the
17 form of a jury instruction. I assume Bio-Rad's going to
18 ignore that and their expert is going to say, "No, we
19 are not limited to having only one template molecule per
20 droplet," and therefore I guess then the appropriate
21 forum would be that we would move to strike that
22 expert's report --

23 THE COURT: No, no, wait a minute. I don't think
24 that's -- let me tell you what I think is appropriate,
25 but I could well be wrong. Here's how I think the rules

1 of civil procedure work.

2 I think I construe the patents as issued, um,
3 limiting myself to intrinsic evidence unless in those
4 rare instances I have to go to extrinsic evidence, which
5 is inconsistent, because this is a jury case. But in
6 any event, I do that. Then their experts do whatever
7 they do and your experts do whatever they do and there's
8 pretrial motions.

9 Now, if this is a big deal, something I don't know
10 yet because, as I approach these cases, I don't know and
11 at this stage I don't want to know anything about the
12 accused device. But once I've roughed this out now, I
13 imagine I'm going to find out a lot about the accused
14 device or devices. And so I'm going to then have that
15 issue of whether the accused device infringes or not.
16 And that is presented in various ways.

17 And I mean there's jurisprudence right on this.
18 If you are right in what you've just argued, they're not
19 going to be able to claim that. So I'm going to apply
20 that jurisprudence and that's going to resolve the
21 matter. If it is not resolved prior to trial, that's
22 the whole purpose of motions in limine. No expert is
23 going to say something that is violative of how I
24 applied the law.

25 But I must say -- and I'm not trying to shirk work

1 here, but I, um, think that moving in an orderly
2 sequence is advisable because the -- constitutionally
3 I'm limited to cases and controversies. So it appears
4 we have one, you people are felling whole forests to
5 convince me that I do, um, but as yet I'm not exactly
6 sure of the contours of the controversy. And I, um,
7 worry, I'll tell you candidly, that I am only one piece
8 of this larger patent and competitive battle, which of
9 course everyone is entitled to engage in. So I'm going
10 to limit what I say until I know I have to say it.

11 And now I guess, foolishly impressed by my own
12 speech, I think maybe I will simply express no opinion.
13 I'm delighted or I'm very interested anyway to get this
14 claim, but I'm not going to address it in my markman
15 ruling. But not addressing it does not in any way
16 suggest it is not a viable, indeed maybe a powerful
17 claim. I express no opinion on it. And I thank you.

18 All right.

19 MS. BROOKS: Thank you very much, your Honor.
20 Thank you for that clarification.

21 THE COURT: Well with that done, I think we are at
22 an end today and I do -- the matters I've taken under
23 advisement, I'll resolve, and I do thank you. And as
24 promptly as I can. It's been a pleasure seeing you all.

25 MR. REINES: Thank you, your Honor.

1 THE COURT: And we'll recess.

2 MS. BROOKS: Thank you, your Honor.

3 (Ends, 3:15 p.m.)

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

C E R T I F I C A T E

I, RICHARD H. ROMANOW, OFFICIAL COURT REPORTER,
do hereby certify that the foregoing record is a true
and accurate transcription of my stenographic notes
before Judge William G. Young, on Thursday, September
10, 2020, to the best of my skill and ability.

/s/ Richard H. Romanow 09-22-20

RICHARD H. ROMANOW Date